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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,258	08/26/2003	Koichi Nishimura	392.1811	2081

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EXAMINER
MACKEY, JAMES P

ART UNIT	PAPER NUMBER
1722	

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/647,258	NISHIMURA ET AL.	
	Examiner	Art Unit	
	James Mackey	1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 September 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 4-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *10 and 11* is/are allowed.

6)☒ Claim(s) *1 and 4-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 19 September 2006 has been entered.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 6, 8 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original disclosure does not describe "a position of at least one element of the adjusting mechanism against the guide face is varied in order to adjust the inclination of the moving platen in a horizontal direction", as claimed in independent claim 1, **and also wherein** each adjusting mechanism includes a rotary roller rotating around the head of a fixing shaft, as claimed in claim 6, **or wherein** each adjusting mechanism includes a plate disposed at the tip of a screw which is screwed to a fixing member, as claimed in claims 8 and 9. In each of these embodiments (as shown and described in relation to Figures 3, 5 and 6), the inclination of the moving platen is adjusted by movement of an element of an adjusting mechanism, but such

movement of said element in these embodiments **is not described** as varying of a position of the element against the guide face as claimed in independent claim 1.

Applicant argues that, in the embodiment of Figures 3 and 7 (corresponding to claim 6), the rotating position of the fixing shaft 12a is varied to thereby vary the projection amount of the head 12b of the fixing shaft; however, the rotary roller 12e is the element which abuts against the guide face (as explicitly claimed in claim 6), and such adjustment of the position of the head of the fixing shaft does not vary the position of the rotary roller "against the guide face" as required in claim 1. In other words, the "position of at least one element of the adjusting mechanism against the guide face" is not varied, since the rotary roller is the element of the adjusting mechanism which is against the guide face, and the position of that rotary roller element against the guide face does not vary upon adjustment of the position of the head of the fixing shaft.

Applicant also argues that, in the embodiment of Figures 5 and 6 (corresponding to claims 8 and 9, respectively), "the projection amount of the slide plate 33 toward the guide face 5 with respect to the fixing member 30 is adjusted"; however, the slide plate 33 (which carries rollers 36 in the embodiment of Figure 6) is the element which abuts against the guide face, and the adjustment of the position of the slide plate **with respect to the fixing member 30** does not vary the position of the slide plate "against the guide face" as required in claim 1.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1, 4, 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shima et al. (U.S. Patent 4,571,169; Figures 1 and 7) in view of either Japanese Patent Document 7-195473 or Sauerbruch et al. (U.S. Patent 3,674,400; Figures 14-16).

Shima et al. disclose a clamping mechanism comprising stationary mold platen 2, movable mold platen 7, and rear platen 8 disposed opposite to the stationary platen with respect to the movable mold platen, with adjustable wedge-type sliding guides 46, 47 located at both the movable mold platen and the rear platen. Each of Japan '473 and Sauerbruch et al. disclose a clamping mechanism including an adjustment mechanism for adjusting the inclination of the moving platen.

Japan '473 discloses a clamping mechanism comprising upper guide faces (on guides 4) formed at an inside surface of a base (the upper guide surfaces are considered to be "inside" with respect to the molds thereabove, since the bottoms of the guides are clearly outside with respect to the molds), and adjusting mechanisms 5 fixed under the moving mold platen 2 so as to freely abut against the guide faces to adjust the inclination of the moving platen (the adjustment of any one of the adjusting mechanisms 5a and 5b clearly causing movement of the moving platen, such movement clearly having a horizontal component and thus reading on the claimed recitation of adjusting the inclination "in a horizontal direction relative to a vertical axis of the moving platen"), the adjusting mechanisms comprising fixing members 8 having a slope and slide plates 20 having a slope adapted to contact the slope of the respective fixing members such that the slide plates are interposed between the fixing members and the guide faces and such that the slide plate face opposite the slide plate slope comes into contact with the respective guide face, wherein the slide plates are attached to the fixing members via screws 16. Adjustment of one of the adjusting mechanisms 5a, 5b clearly results in varying the position of the slide plate against the guide face, as claimed in claim 1.

Sauerbruch et al. disclose a clamping mechanism comprising guide faces 11 formed on an inside surface of a base 10 (the upper guide surfaces are considered to be "inside" with respect to the molds thereabove, since the bottoms of the guides are clearly outside with respect to the molds), and at least two adjusting mechanisms fixed to the underside of the moving platen 5 and including at least one element 19, 29, 31 (Figures 14-16) which abuts and adjusts against the guide face and is capable of adjusting the inclination of the moving platen "in a horizontal direction relative to a vertical axis of the moving platen" as claimed (adjustment of one element

19, 29, 31 on one side of the moving platen will clearly tilt the moving platen and thus will incline the moving platen relative to the vertical axis, such inclination clearly including a horizontal component). In one embodiment (Figure 15), the adjusting mechanisms include a fixing member 27'' attached to the moving platen and having a slope, a slide plate 31 having a slope contacting the slope of the fixing member and a face opposite the slope thereof which contacts the guide face, and a screw 30' attaching the slide plate to the fixing member, such that a position of the slide plate 31 against the guide face is varied during adjustment.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Shima et al. by providing the rear platen adjusting mechanism as the mechanism disclosed in either Japan '473 or Sauerbruch et al. in order to facilitate adjustment of the inclination of the rear platen, especially considering that the platen adjustment mechanisms of each of Shima et al., Japan '473 and Sauerbruch et al. are equivalents in the art.

With regard to the adjusting mechanisms being mounted to the base for cooperation with guide faces formed at a side surface in the lower portion of the rear platen (claim 5), it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Shima et al., as modified by either Japan '473 or Sauerbruch et al., by providing the adjusting mechanisms mounted to the base for cooperation with guide faces formed at a side surface of the lower portion of the moving platen, since a skilled artisan would have recognized that the adjustable support of the rear platen would function equally well with the guide faces and cooperating adjusting mechanisms located at either the base or the rear platen, and since such amounts to the mere reversal of location of parts without affecting the functioning of the machine; note that it has generally been recognized that to shift location of parts when the

operation of the device is not otherwise changed is within the level of ordinary skill in the art, see *In re Japikse*, 86 USPQ 70, and *In re Gazda*, 104 USPQ 400.

8. Claims 10 and 11 are allowed.

The prior art of record does not teach or fairly suggest a clamping mechanism including at least two adjusting mechanisms cooperating with a rear platen and a base, the adjusting mechanisms being adjustable such that the rear platen is inclined in a horizontal direction relative to a vertical axis of the rear platen, as claimed in claims 10 and 11. While it is known in the art to provide a rear platen with an adjusting mechanism, as disclosed in Shima et al., such a known adjusting mechanism is not adjustable such that the rear platen is inclined in a horizontal direction relative to a vertical axis of the rear platen.

9. Applicant's arguments filed 19 September 2006 have been fully considered but they are not persuasive.

Applicants argue that none of JP '473, JP '918 or Sauerbruch et al. disclose or suggest that the adjustment mechanism or the guide face is formed at either one of a **rear platen** and a base, since each of the references discloses such elements formed at either one of a moving platen and a base; however, Shima et al. suggest providing similar adjustment mechanisms at either the moving platen or the rear platen for adjustable cooperation with a slide base.

Applicants argue that Shima et al. do not disclose or suggest that slide metals 46, 47 are used to adjust the bearing platen 8 in a horizontal direction about a vertical axis; however, such an argument is not commensurate in scope with claim 1, which does not require means to adjust the inclination of the rear platen in a horizontal direction **about a vertical axis**, but merely means to adjust the inclination of the rear platen in a horizontal direction. Shima et al. clearly

has wedge-type adjustment mechanisms on the rear platen, whereby inclination of an individual one of the adjustment mechanisms clearly results in a rear platen position adjustment (about a horizontal axis), such position adjustment clearly having a horizontal component. Note also that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations, *Ex parte Masham*, 2 USPQ2d 1647; see also *In re Finsterwalder*, 168 USPQ 530, and *In re Casey*, 152 USPQ 235.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mackey whose telephone number is 571-272-1135. The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James Mackey
Primary Examiner
Art Unit 1722

9/26/06

jpm
September 26, 2006